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JULY 28,99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Standard Motor Products, Inc.

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Serial No. 75/049,284

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I. Walton Bader for Standard Motor Products, Inc.

Janice L. McMorrow, Trademark Examining Attorney, Law  
Office 104 (Sidney Moskowitz, Managing Attorney)

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Before Cissel, Hanak and Chapman, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Standard Motor Products, Inc. seeks to register EIS  
XTENDER and design in the form shown below for "repair  
parts for automobile and truck brakes, namely semi-metallic  
brake pads." The octagon surrounding the letters EIS is  
lined for the color red, and the word XTENDER is lined for  
the color gold. The application was filed on January 26,  
1996 with a claimed first use date of 1984.

The Examining Attorney refused registration pursuant to Section 2(d) of the Lanham Trademark Act on the basis that applicant's mark, as applied to applicant's goods, is likely to cause confusion with the mark THE EXTENDER, previously registered in the form shown below for "oil filters for land vehicle engines." Registration No. 1,610,512.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining

Attorney filed briefs. Applicant requested and then waived an oral hearing.

In any likelihood of confusion analysis, two key considerations are the similarities of the goods and the similarities of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of the differences in the essential characteristics of the goods and differences in the marks.").

Considering first the goods, both applicant's brake pads and registrant's oil filters are installed on land vehicles such as automobiles and trucks and, as applicant concedes, travel in the same channels of trade in that there are "stores selling both oil filters and brake parts." (Applicant's reply brief page 5). Applicant argues, without evidentiary support, that "oil filters and brake parts are, in many cases, sold in different types of stores. Thus, for example, oil filters are sold in discount stores and department stores that do not sell brake parts." (Applicant's reply brief pages 4-5). Even accepting applicant's argument that there may be some stores which carry oil filters but not brake pads, the fact

remains there are a substantial number of stores which carry both oil filters and brake pads.

Moreover, the Examining Attorney has made of record a significant amount of evidence showing that both oil filters and brake pads are sold by numerous different companies under the identical trademarks. Thus, a consumer would not in any way be surprised to find the identical trademark on a brake pad (or its packaging) and on an oil filter (or its packaging).

Finally, we note that applicant, again without any evidentiary support whatsoever, argues that brake pads are "normally purchased by skilled automotive mechanics." (Applicant's brief page 8). Even assuming the correctness of this assertion, the fact remains that applicant is implicitly conceding that brake pads are also purchased by ordinary individuals who repair their own cars or trucks. Moreover, there is nothing in the record to demonstrate that skilled automotive mechanics would believe that brake pads and oil filters bearing very similar marks would come from different companies. Indeed, given the Examining Attorney's extensive evidence demonstrating that the same companies market both brake pads and oil filters under the identical trademarks, it is much more likely that even skilled automotive mechanics would believe that brake pads

and oil filters bearing very similar marks would come from the same source.

In short, we find that brake pads and oil filters for automobiles and trucks are fairly closely related goods which travel, at least in part, in the same trade channels and which are purchased, at least in part, by ordinary individuals who do their own work on their automobiles and trucks. Moreover, we find that it is not at all uncommon for manufacturers to produce both brake pads and oil filters and to affix the identical trademarks to them.

Turning to a consideration of the marks, it need hardly be said that the two marks must be compared in their entirety. However, in making this comparison, it is not inappropriate to give more weight to particular elements of each of the marks if those elements are more prominent. In considering registrant's mark THE EXTENDER, it is readily apparent that the word EXTENDER appears in lettering which is much larger than the lettering used for the word THE. Moreover, the word "the" is a very weak source identifier.

In an effort to distinguish its mark from the registered mark, applicant makes much of the fact that the mark it seeks to register includes its house mark EIS. (Applicant's brief page 4). What applicant fails to recognize is that as a general rule, an applicant cannot

justify the "use of another's mark simply by tacking its own house mark or trade name" on to the other mark. See 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 23:43 at page 23-94 (4<sup>th</sup> ed. 1999) and cases cited therein. This is particularly true when the house mark appears in a very subordinate fashion, as do the letters EIS in applicant's mark. Obviously, as noted, the letters in the word XTENDER in applicant's mark are far larger than are the letters in the EIS portion.

In short, while we are comparing applicant's mark and registrant's mark in their entireties, we find that by far the most prominent portion of applicant's mark is the word XTENDER and that by far the most prominent portion of the registered mark is the virtually identical word EXTENDER. Obviously, these two words are phonetically identical. A potential purchaser calling an auto supply store and requesting EXTENDER or XTENDER oil filters or brake pads would pronounce both words in the identical manner, and the receiver of the call would have no way of distinguishing these two words when they are spoken.

Moreover, in terms of connotation both words are identical in that, they suggest that the products (brake pads and oil filters) extend the useful life of the automobile or truck.

We note that applicant has made of record six third-party registrations wherein the word EXTEND appears. There are two problems with these third-party registrations. First, none of the registrations cover automotive or truck parts, or any goods related thereto. Century 21 Real Estate v. Century Life, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). Second, with one exception, the third-party registrations do not include variations of the word EXTENDER. Rather, the marks involved are as follows: EXTENDED LIFE; EXTEND-A-PHONE; EXTEND-A-CELL; EXTEND-A-LINE and EXTEND. The sixth mark, EXTENDOR, is registered for disposable pipette tip extenders.

Thus, applicant has totally failed to prove that in the automotive and truck parts field, the mark THE EXTENDER is in any way a weak mark entitled to a lesser scope of protection.

Given the fact that applicant's mark and registrant's mark are essentially identical in terms of pronunciation and connotation and that they are at least somewhat similar in terms of visual appearance, we find that their use on fairly closely related goods (i.e. automobile and truck replacement parts) is likely to result in confusion. In stating that these two marks are virtually identical in terms of their pronunciation, we believe that consumers

would hardly even notice the letters EIS in applicant's mark given their extremely small size and given the additional fact that these letters are within in a hexagon. Moreover, to the extent that consumers would notice these extremely small letters EIS, we believe that many consumers would nevertheless pronounce applicant's mark as simply XTENDER.

As for the fact that two marks are at least somewhat similar in visual appearance, we note that at pages 4 and 6 of its brief and at page 3 of its reply brief, applicant points out that its mark is lined for the colors red and gold or red and yellow. Applicant then points out that registrant's mark is not lined for color. However, what applicant fails to note is that this simply means that registrant's mark is not limited to any particular colors. See In re Data Packaging Corp., 453 F.2d 1300, 172 USPQ 396 (CCPA 1972). In Data Packaging, the Court held that both registered word marks not depicted in special form as well as those registered in a particular design format are "not limited to a particular color, unless lined for color." Data Packaging, 172 USPQ at 397. While we would not base our likelihood of confusion analysis upon the assumption that registrant does or could depict its mark such that the word THE appears in the identical shade of red as does the



hexagon in applicant's mark and that the word EXTENDER appears in the identical shade of gold or yellow as does the word XTENDER in applicant's mark, by the same token, by its registration, registrant has gained the rights to depict its mark in all colors including yellow or gold. Thus, we find that in terms of visual appearance, the two marks are at least somewhat similar.

Decision: The refusal to register is affirmed.

R. F. Cissel

E. W. Hanak

B. A. Chapman  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board

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